

REMARKS

Claims 1-25 are pending in this application.

As an initial matter, Applicant acknowledges with appreciation the reconsideration and withdrawal of the claim rejections under 35 U.S.C. § 103(a) included in the Office Action of September 14, 2007. For at least the reasons outlined in more detail herein, Applicant respectfully requests reconsideration and withdrawal of the new claim rejections under § 103(a) included in the present Office Action of April 22, 2008

I. Claim Rejection under 35 U.S.C. § 103(a) based on Johns and Willis

In the present Office Action, claims 1, 2, and 6-12 were rejected under 35 U.S.C. § 103(a) as being allegedly obvious based on WO 02/16511 to Johns et al. ("Johns") in combination with U.S. Patent No. 5,169,443 to Willis et al. ("Willis"). Office Action at 2. Claim 1 is the only independent claim included in that claim rejection, and Applicant respectfully traverses the rejection of claim 1 based on Johns and Willis because the Office Action has failed to establish that independent claim 1 is *prima facie* obvious.

According to the M.P.E.P., in order to establish a *prima facie* case of obviousness, the record must "include[] findings of fact concerning the state of the art and the teachings of the references . . ." The Manual of Patent Examining Procedure ("M.P.E.P.") § 2141(I) (8th ed. rev. 6 Sept. 2007) (relying on KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 82 U.S.P.Q.2d (BNA) 1385 (2007), and confirming the legal framework established by Graham v. John Deere Co., 383 U.S. 1, 17, 148 U.S.P.Q. (BNA) 459, 467 (1966)). Moreover, "[o]nce the findings of fact are articulated, [the

rejection statement] must provide an explanation to support an obviousness rejection under 35 U.S.C. [§] 103.” Id. If it is found that the prior art references fail to disclose all of the subject matter recited in a claim, the rejection statement “must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” § 2141(III).

Applicant respectfully submits that the rejection statement fails to explain why the differences between Johns and Willis and the subject matter recited in independent claim 1 would have been obvious to one of ordinary skill in the art for at least the reasons outlined below.

Applicant’s independent claim 1 is directed to a pigment product including, *inter alia*, “kaolin having a particle size distribution such that at least about 85% by weight of the particles have an equivalent spherical diameter less than about 2 µm, and from about 10% to about 20% by weight of the particles have an equivalent spherical diameter less than about 0.25 µm” Applicant respectfully submits that neither Johns nor Willis discloses at least this subject matter recited in Applicant’s independent claim 1, and further, the rejection statement has failed to explain why at least this difference between Johns and Willis and the subject matter recited in independent claim 1 would have been obvious to one of ordinary skill in the art.

For example, the rejection statement asserts that Johns discloses kaolin, “such that not more than 10% by weight has a particle size of less than 0.25 µm and not less than 30% by weight has a particle size of less than 2 µm (Abstract; page 2, lines 26-29; page 15, lines 5-10).” Office Action at 2 (emphasis added). Applicant respectfully submits that the rejection statement has misinterpreted Johns by alleging that Johns

discloses a kaolin, such that not less than 30% by weight has a particle size of less than 2 μm . Indeed, the Abstract in Johns itself discloses

wherein the kaolin of the feed suspension in step (a) is such that not more than 30 % by weight has a particle size less than 2 μm . . . and wherein the kaolin of the product suspension produced in step (e) is such that . . . not more than 10% by weight has a particle size less than 0.25 μm .

(Abstract). Moreover, the portion of Johns at p. 2 cited by the rejection statement recites a similar description. Thus, the Abstract and p. 2 of Johns do not support the rejection statement's allegation that Johns teaches a kaolin, such that not less than 30% by weight has a particle size of less than 2 μm .

The rejection statement also refers to Johns at page 15, lines 5-10, as supporting its allegation that Johns discloses a kaolin, such that not more than 10% by weight has a particle size of less than 0.25 μm and not less than 30% by weight has a particle size of less than 2 μm , and that this range overlaps the particle size distribution of the pending claims. See Office Action at 2. In particular, the rejection statement asserts that Johns teaches ranges of particle size distribution, shape factor, and steepness that overlap with respect to the pending claims, and further, that overlapping ranges have been held to establish *prima facie* obviousness. Id. at 3-4.

Applicant respectfully submits that a *prima facie* case of obviousness based on overlapping ranges is rebuttable by showing the criticality of the claimed range through, for example, a showing of unexpected results. See MPEP § 2144.05(III). Thus, even if for the sake of argument, the rejection statement has hypothetically established a *prima facie* case of obviousness, Applicant respectfully submits that the ranges recited in Applicant's independent claim 1 are critical at least because the pigment product recited

in independent claim 1 has achieved unexpected results. For example, the pigment product recited in independent claim 1 unexpectedly retains the gloss, brightness, and/or opacity characteristics generally only associated with prior products that include higher amounts of expensive pigments in order to attain that level of gloss, brightness, and/or opacity. See Applicant's Description at p. 4, ¶¶ [014] - [015]. In particular, the Description explains that the pigment products of the claimed particle size distribution, shape factor range, and steepness range of the pending claims achieve unexpected results over the ranges disclosed in Johns. Further, as explained below, the Johns disclosure is directed to the use of kaolin products as super-calendar paper fillers and is silent with respect to the use of its disclosed kaolin products as pigment products or coating compositions.

In addition, the rejection statement concedes that Johns does not expressly teach that the kaolin is derived from a crude secondary kaolin, as is recited in Applicant's independent claim 1. See Office Action at 3. The rejection statement asserts, however, that based on the teachings of Willis, it would have purportedly been obvious to the skilled artisan to have modified the Johns disclosure in order to use sedimentary kaolin from the Para State region of Brazil, and further, that the skilled artisan would have been motivated by Willis's disclosure that such deposits provide delaminated kaolin pigments having desirable low viscosity and optical properties. Id.

Applicant respectfully disagrees with the rejection statement's assertions. As conceded by the rejection statement, Johns expressly discloses a kaolin particulate and a method of producing the same, wherein the kaolin is used in improved super-calendared paper as a filler and not a pigment. See Office Action at 2 (citing Johns at

Abstract, p. 1, ll. 3-5; 25-30). Indeed, Johns discloses that generally, super-calandered papers are highly filled, uncoated calendered papers having properties similar to coated papers. See Johns at p. 1, ll. 25-27. While Johns may teach the use of its kaolin products as improved fillers for uncoated paper, it does not expressly disclose that the kaolin products may be used as pigment products or coating compositions. As acknowledged by the rejection statement, Willis, in contrast, discloses paper coating kaolin pigments. See Office Action at 3. Applicant respectfully submits that one of ordinary skill in the art would not have modified Johns based on the disclosure of Willis, at least because Johns and Willis are directed to different uses of kaolin, in particular, the use of kaolin as fillers versus the use of kaolin as paper coating pigments.

For at least the above-outlined reasons, the pigment products of the claimed invention exhibit unexpected results over the cited art, and the skilled artisan would not have modified the teachings of Johns in view of Willis.

Therefore, Johns and Willis, regardless of whether they are viewed individually or in combination, fail to support a *prima facie* case of obviousness with respect to independent claim 1. For at least this reason, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 2, and 6-12 under 35 U.S.C. § 103(a) based on Johns and Willis.

II. Claim Rejections under § 103(a) based on Cummings in Combination with One or More of Johns, Willis, Bown, and Shi

Claims 1-9 and 13-25 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious based on U.S. Pat. App. Pub. No. 2003/0177952 to Cummings et al. (“Cummings”) in combination with one or more of Johns (Office Action at 4), Willis (Id.

at 11), U.S. Patent No. 6,003,795 to Bown et al. ("Bown") (Id. at 12), and U.S. Patent No. 5,089,056 to Shi et al. ("Shi") (Id. at 13). Applicant respectfully traverses each of those rejections at least because Cummings does not qualify as prior art with respect to the present application under 35 U.S.C. § 103(a) as set forth in 35 U.S.C. § 103(c).

According to 35 U.S.C. § 103(c)(1),

[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Thus, if a reference qualifies as prior art only under §§ 102(e), 102(f), and/or 102(g), and the subject matter disclosed in the reference and the subject matter claimed were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person, the reference does not qualify as prior art under § 103(a) with respect to the claims of the application.

Applicant respectfully submits that Cummings does not qualify as prior art against the claims of the present application because (1) Cummings qualifies hypothetically as prior art, if at all, only under §§ 102(e), 102(f), and/or 102(g); and (2) at the time the invention disclosed in the present application was made, Cummings and the subject matter claimed in the present application were owned by the same entity or subject to an obligation of assignment to the same entity, as will be explained in more detail below.

First, Cummings fails to qualify as prior art under 35 U.S.C. § 102(a) or (b). The present application claims priority to an international filing date of August 15, 2003, and

a foreign filing date of August 16, 2002. Since the publication date of Cummings (September 25, 2003) is not prior to either the international or foreign filing date, Cummings is not prior art under 35 U.S.C. § 102(a) or (b). See 35 U.S.C. §§ 102(a) and 102(b). Further, Cummings does not qualify as prior art under §§ 102(c) or 102(d), since no evidence has been presented that Applicant for the present application either “abandoned the invention” (see § 102(c)), or received a foreign patent or inventor’s certificate for “the invention . . . more than twelve months before the filing” of the present application (See § 102(d)). Therefore, Cummings may only qualify as prior art with respect to the present application, if at all, under §§ 102(e), 102(f), and/or 102(g).

Furthermore, Applicant respectfully submits that at the time the present invention disclosed in the present application was made, as described via exemplary embodiments disclosed in the application, the subject matter of Cummings and the present application’s claims, were subject to an obligation of assignment to Imerys Pigments, Inc. This obligation is evidenced by an Assignment of Cummings to Imerys Pigments, Inc., which was recorded in the U.S. Patent and Trademark Office (USPTO) on July 18, 2002, at Reel 013098, Frame 0573, and an Assignment of the present application to Imerys Pigments, Inc., which was recorded in the USPTO on September 9, 2005, at Reel 016767, Frame 0301.

For at least the above-outlined reasons, Cummings does not qualify as prior art under 35 U.S.C. § 103(a) pursuant to the exclusionary provision of 35 U.S.C. § 103(c). Therefore, Applicant respectfully requests withdrawal of the claim rejections under 35 U.S.C. § 103(a) based on Cummings in combination with one or more of Johns, Willis, Bown, and Shi. Despite the fact that Cummings does not qualify as prior art

under 35 U.S.C. § 103(a) for at least the above-outlined reasons, Applicant reserves the right to supplement the traversal of the § 103(a) claim rejections based on Cummings with additional remarks in the future if appropriate.

III. Conclusion

For at least the reasons outlined above, Applicant's independent claims 1 and 14 should be allowable. Dependent claims 2-13 and 15-25 respectively depend from allowable independent claims 1 and 14. For at least this reason, those dependent claims should also be allowable.

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application, withdrawal of the claim rejections, and timely allowance of pending claims 1-25.

Applicant respectfully submits that the Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

If the Examiner believes that a telephone conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant's undersigned attorney at (404) 653-6559. Please grant any extensions of time required to enter this Request and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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